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Remarks/Arguments

Claims 20-25, 27-45, 47-50, 52-71, 73-84, 86-114, and 116-117 are currently pending in the application. Claims 20-28, 35, 54-55, 66-74, 79 and 103-111 have been amended for clarification. All pending claims are fully supported by the specification, and no new matter has been added to the application. For at least the reasons presented below, Applicant asserts that the pending claims are in condition for allowance.

1. 35 U.S.C. § 103 Rejections

Claims 20-25, 27-45, 47-50, 52-71, 73-84, 86-114, and 116-117 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dworkin, U.S. Patent No. 4,992,940 (hereinafter "*Dworkin*"), in view of *Eastep*, U.S. Patent No. 6,731,625 B1 (hereinafter "*Eastep*"). After thorough review of the cited prior art, Applicant respectfully disagrees with the characterization and combination of *Dworkin* and *Eastep*, and respectfully requests reconsideration and withdrawal of the rejections.

The presently claimed invention discloses a method, system, and computer program that provides for a framework manager to provide for collaborative planning. The steps of the method claim, to which the steps of the system and computer program claim correspond, detail a series of steps that *enable a framework manager to provide for collaborative planning*:

- (a) providing a network for use by at least a first business entity and a second business entity, wherein the first and second business entities comprise at least one of service providers, vendors, resellers, and manufacturers;
- (b) using the network to receive information from at least a first business entity, including information relating to a demand of at least the first business entity for offerings;

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- (c) using the network to receive information from at least a second business entity, including information relating to a supply of offerings from at least the second business entity;
- (d) comparing the supply and the demand for the offerings;
- (e) using the comparison of the supply and the demand for the offerings to plan future supply and demand for the offerings;
- (f) using the network to facilitate planning between at least the first business entity and the second business entity;
- (g) using the network to provide data access from multiple simultaneous data sources using a network for demand and supply planning in a network-based supply chain having at least one service provider and at least one manufacturer;
- (h) using the network to store capacity data; and
- (i) wherein the step of storing capacity data using the network includes replication and synchronization capabilities.

See Claim 20 (emphasis added); see also Claims 66 (computer program claim), 103 (system claim).

An invention is considered an obvious modification of the prior art when the prior art provides some motivation or suggestion to combine the references asserted, and that *all* limitations of the claimed invention are taught or suggested by the prior art. See MPEP § 2143. In the present case, *Dworkin* and *Eastep* individually fail to provide any suggestion or motivation for their combination, and *Dworkin* in view of *Eastep* fails to teach or suggest all limitations of the claimed invention.

A. Lack of Motivation or Suggestion

No motivation or suggestion exists, either explicitly or implicitly, within the cited art references to suggest that these references be combined. As such, the combination is inappropriate to render Applicant's claimed invention obvious. "The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01

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(citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)). This principle aptly applies in the present case because, after a thorough review of both *Dworkin* and *Estep*, it is apparent that there is no suggestion or motivation for their combination.

Dworkin discloses an invention providing a user the ability to locate goods or services from multiple vendors through the use of a network which consolidates vendor offerings for easier review by the user. See *Dworkin*, e.g., at Abstract; col. 2, ll. 6-18. The user's own demand of a good or service drives the selection and evaluation of the plurality of goods or services offered by the plurality of vendors. *Id.*

Estep discloses a callback system which coordinates a telecommunication system that facilitates a callback service to permit conference calling. See *Estep*, e.g., at abstract; col. 2, ll. 25-38. *Estep* accomplishes this coordination through use of a network and the internal coordination of switch resources to accommodate multiple callers into a single call. See, e.g., *Id.* at Abstract. Unlike *Dworkin*, the invention disclosed in *Estep* does not coordinate the demand for goods of separate purchasers by a centralized entity; instead *Estep* seeks to coordinate availability of available circuits to facilitate a conference call within the network. *Id.*

From the discussion above, it is clear the *Dworkin* and *Estep* are directed toward different situations. The combination of *Dworkin* and *Estep* is inappropriate and speculative at best. Further, there is no indication as to any benefit derived from their combination. Adding the functionality of *Dworkin* to *Estep*, permitting a user of services to evaluate and choose services available, renders the *Estep* invention inefficient because *Estep* is based on automated selection of available circuits. Similarly, *Dworkin* would not be improved by the elements added by *Estep* because the user of *Dworkin* would intrinsically perform the *Estep* functions. Hence, without motivation or suggestion to

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combine *Dworkin* and *Estep*, rejection based on the two is improper and should be withdrawn.

In fact, *Estep* could not provide adequate suggestion or motivation because of the minimal attention provided to the elements on which *Estep* is relied. Reviewing the text of *Estep* reveals that the terms "planning" and "comparing" are individual words considered out of context. The discussion of each element in *Estep* amounts to a single sentence. Neither citation to *Estep*, nor the surrounding text, provides any substantive discussion on the elements relied upon. See, *Estep*, col. 37, ll. 18-19 (using the word "comparing" in the context of authenticating a user for inclusion in a conference call, not in the context of comparing the demand or supply of goods or services); col. 52, ll. 20-23 (discussing the collection of data about the ISP, not planning future supply and demand). Merely because both *Estep* and *Dworkin* contemplate the supply or demand of services or goods through the use of a network, and arguably at best, does not mean their combination will automatically result in a supportable combination. Without provided suggestion or motivation to combine the two, their combination without such explanation is inappropriate and the rejection should be withdrawn.

B. The References in Combination Fail to Teach All Limitations of the Claimed Invention

Equally troubling to the lack of motivation for combining *Dworkin* and *Estep* is that the failure of these references, in combination, to teach or suggest all limitations of the claimed invention. Principle to any rejection based upon obviousness is that the combination of prior art references teach or suggest all claim limitations of the claimed invention. MPEP § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *Id.* (quotation removed). In the present case, neither *Dworkin* nor *Estep*, alone or in combination, teach or suggest all the claim limitations of Applicant's invention, as amended.

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Preliminarily, it should be noted the claimed invention involves a framework manager which functions as the entity that performs the steps of the method claimed, as well as uses the computer program and system claimed. *Dworkin* in view of *Eastep* fails to teach, suggest, or even contemplate the operation of a framework manager that performs the method steps of the invention, and uses the method claimed. In fact, *Dworkin* teaches away from the use of a framework manager to manage supply and demand offerings because the party purchasing goods or services actively uses the network. In contrast, in the present invention this party takes a passive role and allows the framework manager to evaluate goods and services. See Claim 20. *Eastep* does not add the framework manager functionality.

Specifically regarding the claim limitations, subpart (a) of Claim 20 is not addressed by the Examiner's rejection. No reasoning is presented as to why or how subpart (a) is an obvious modification of *Dworkin* in view of *Eastep*. *Dworkin* nor *Eastep* provide for a framework manager to coordinate, plan, or compare the goods or services supplied or demanded. As explained *supra*, *Dworkin* teaches away from the use of a framework manager because the user of the invention acts as the party demanding products or services. In the present invention, the framework manager independently coordinates and plans the supply and demand of goods or services. *Dworkin* in view of *Eastep* fails to teach or suggest any use of a framework manager. Hence, rejection under this prior art should be withdrawn. Applicant respectfully requests withdrawal of the rejections, and that a notice of allowance be issued.

C. Dependent claim rejections

Dependent claims 21-25, 27-45, 47-50, 52-65, 67-71, 73-84, 86-102, 104-114, and 116-117 are also in condition for allowance because the independent claims are allowable.

"If an independent claim is nonobvious under 35 U.S.C. [§] 103, then any claim depending

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therefrom is nonobvious." MPEP § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)). Because independent claims 20, 66, 103 are nonobvious and allowable over the prior art, the claims depending from such claims are likewise allowable. Applicant respectfully requests withdrawal of the rejections, and that a notice of allowance be issued.¹

2. Conclusion

All rejections having been addressed, Applicant submits that all pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the rejected claims and that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 612-607-7387. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 060021-335501).

Respectfully submitted,



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¹ Applicant further reserves its right to further argue the allowability of the dependent claims individually from the independent claims. However, because the independent claims are in condition for allowance, further argument regarding the dependent claims is unnecessary.